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09/817,719	03/26/2001	Sri K. Canakapalli	INTL-0558-US (P11216)	9468

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EXAMINER

NELSON, ALECIA DIANE

ART UNIT

PAPER NUMBER

2675

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**AUG 25 2003**

**Technology Center 2600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 8

Application Number: 09/817,719  
Filing Date: March 26, 2001  
Appellant(s): CANAKAPALLI, SRI K.

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Timothy N. Trop  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed July 31, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

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**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 7-10 do stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

6,115,029                      JAAKELAINEN, JR et al.              9-2000

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 7-10 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper No. 5.

**(11) *Response to Argument***

It is argued on page 4 of the Appeal brief, lines 2-10, that Jaaskelainen does not recite or suggest a control to enable the user to manually change the rate at which the cursor image moves in response to the movement of a control positioned to lie under the user's thumb when the body is positioned in the user's hand. However, it would be obvious that the user will have to operate switch (80) with his/her thumb, being that it is the only available appendage to operate switch (80) when the index finger is to be

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positioned over mouse button (42). It would also be possible for the user to contort his/her hand to allow placement of the thumb to fall over the switch (80). Moreover, claim 7 is directed to an apparatus, which comprises the limitations as recited as opposed to the specific structure of the mouse wherein said structure has an intended purpose. *In re Japikse*, 86 USPQ 70 (CCPA 1950) states that there would be no invention in shifting the location of parts to a different position since the operation of the device would not thereby be modified.

Also, it is stated on page 4, line 20-page 5, line 2 in order for the reference to be inherent, it must necessarily do what is claimed. Further it is stated that the reference does not necessarily do what is claimed but, as stated by the Examiner, it is possible that it might do so, and that the possibility is not sufficient to make out an inherency rejection and therefore, the reference taken by itself simply teaches away from the claimed invention. MPEP 2112 states that a rejection is proper when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic. In the case of Jaaskelainen the reference is identical except it is silent as to the positioning of the thumb with relation to switch (80). The examiner has provided rational as explained above, and in the previous office actions, by providing a basis in fact and/or technical reasoning to reasonably support the determination that the characteristic of switch (80) being positioned as to be operated by the thumb necessarily flows from the teachings of the applied prior art.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

adn/ADN  
August 22, 2003

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